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THE DIAL CORPORATION
19001 N. Scottsdale Road
SCOTTSDALE, AZ 85255

EXAMINER	
SOROUSH, LAYLA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/784,488
Filing Date: February 15, 2001
Appellant(s): GALANTE ET AL.

Paul A. Pappalardo
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 11, 2008 appealing from the Office action mailed June 25, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 99/23998	Banowski et al.	05-1999
(Translated: US6,569,438)		
5968489	Swaile et al.	10-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 7, 9, and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Banowski et al. (WO 99/23998 as translated by US 6,569,438).

Banowski et al. teach dermatological stick formulations comprising antiperspirant agents such as sodium aluminium chlorohydroxylactate (See US 6,569,438 @ col. 3, lines 5-23) and two or more separate, differently composed gel phases, wherein the phases contain deodorant or perspiration-inhibiting actives. See US 6,569,438 @ col. 1, lines 47-60; col. 3, lines 1-22. The phases may differ in color and/or content of polymer powder and the active ingredients. See col. 4, lines 38-42. The compositions Banowski et al. contain water, gelling agents, waxes, polyhydric alcohols and other conventional cosmetic agents; for example magnesium stearate. See col. 2, lines 3-33; Examples. The core phase of the composition may be cylindrical or “be arranged parallel to the longitudinal axis of the stick”. See col. 5, lines 10-18. With respect to the claimed limitation “one portion is firmer that, and provides support for the other portion”, it is noted that some compositions exemplified by Banowski et al. contain different amount

of waxes in core part ("K") and shell or jacket part ("H"), which would result in different firmness of the compositions. See, for example, col. 10, lines 50-60 (K9 and H6 composition).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8, 13, 16, 20, 21, 61, 63 and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banowski et al. (WO 99/23998 as translated by US 6,569,438) as applied to claims 1, 5, 7, 9, and 11 in view of Swaile et al. (US 5,968,489), all of record.

Banowski et al. does not teach the hydrophilic vehicle in the percentage of the instant claims.

Swaile teaches hydrophilic vehicles in the percentage claimed (see Examples). Also, antiperspirant actives (i.e. aluminum and zirconium salts) are well known and widely used in the art of antiperspirant compositions, as taught by Swaile et al. (col. 9-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the dose range of Banowski et al.'s compound by routine experimentation (see 2144.05 11). The motivation to optimize the dose range of

the Banowski et al.'s final formulation is because one would have had a reasonable expectation of success in achieving the safest clinical outcome.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art." *Id.* at 1739, 82 USPQ2d at 1395. In the instant case, all the claimed element are found in the prior art as discussed above and using the amount of hydrophilic vehicle and antiperspirant salts of Swaile et al. in the deodorant/antiperspirant compositions of Banowski et al. is nothing more than "predictable use of prior art elements according to their established functions." *Id.* at 1740, 82 USPQ2d at 1396.

(10) Response to Argument

A prima facie case of anticipation has been established. Appellant argues that the prima facie case of anticipation has not been established. Particularly, Appellant argues that Banowski et al. does not teach each separate portion "of the composition be anhydrous and hydrophobic." Further, Appellant argues Banowski et al. teaches very high levels of hydrophilic materials including water, ethanol, glycerin, and propylene glycol in various combinations.

The claims are drawn to …a first and second composition comprising an antiperspirant salt suspended in an anhydrous, hydrophobic vehicle… The Examiner states that the claims do not encompass a specific amount of hydrophobic vehicle and do not exclude other hydrophilic vehicles. The Examples of Banowski contain the antiperspirant suspended in both hydrophobic and hydrophilic vehicles, hence meeting the limitation suspended in a hydrophobic vehicle. The comprising language of the claim in the instant invention is open-ended and does not exclude additional, unrecited elements. Therefore, the composition of the instant claim does not exclude ethanol, glycerin, and propylene glycol. Additionally, the exemplified Formulations K3, k4, k6, k8, K10- K15, H3, H4, H6, H8, etc. (col 5-9) of Banowski do not comprise water meeting the limitation anhydrous.

Further, Appellant's argument with regard to the Banowksi in view of Swaile et al. rejection of claims 8, 13, 16, 20, 21, 61, 63 and 66-67 is not persuasive. Appellant's sole argument is that the method of manufacturing Banowksi is different than the process of manufacturing the composition of the invention herein. Therefore, "It was not obvious for Banowski to completely alter their high water, high alcohol, gelled compositions into Applicant's anhydrous, hydrophobic compositions with significant levels of silicones because the portions couldn't be molded sequentially as described by Banowski (see page 17 Appeal brief)."

In response, the Examiner states the claimed composition does not require silicone as argued by Appellant. Therefore, the argument that it is not obvious to alter Banowski's composition into a high silicone composition is not persuasive. The

Examiner will respectfully reiterate the response to arguments above as the same rational is applicable. The claims are not limited to a certain amount of hydrophobic vehicle. The comprising language of the claim in the instant invention is open-ended and does not exclude additional, unrecited elements. Therefore, the composition of the instant claim does not exclude ethanol, glycerin, and propylene glycol.

The objective evidences on the record are not sufficient to overcome the anticipation and obviousness rejections.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617

Conferees:

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

/Layla Soroush/
Examiner, Art Unit 1617